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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,172	01/29/2001	John L. Cartier	09221-P01	9721

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PERKINS, SMITH & COHEN LLP  
ONE BEACON STREET  
30TH FLOOR  
BOSTON, MA 02108

EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 08/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/772,172	<b>Applicant(s)</b> CARTIER, JOHN L.	
	<b>Examiner</b> Victor S Chang	<b>Art Unit</b> 1771	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. The Examiner has carefully considered Applicant's amendments and remarks filed on 7/7/2003. Applicant's amendments to claim 1 and newly added claims 6-11 have all been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

### *Claim Objections*

4. The amendment filed 7/7/2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

It is noted that newly amended claim 1 now recites in part "an integral, one-piece ... cover material ... sealed around its edges ... with said cover extending over both sides of the cover material" (Amendment, page 2). While the Examiner notes that all the aforementioned elements may be inherent for a sealed cover material, it is noted that Applicant fails to point out the existence of any express or inherent support in the Specification. The Examiner further notes that the previously deleted phrase "sealed into one unit" in originally submitted claim 1, line 7 (see Amendment filed 3/6/2003),

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appears to be the only recitation which provides some sort of support to the newly added element "one-piece".

Applicant is required to either point out the support in the Specification, or cancel the new matter in the reply to this Office Action.

***Response to Amendment***

5. Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by Onderak et al. (US 4403009), substantially for the reasons set forth in sections 4 of Paper No. 13, together with the following additional observations.

The Examiner notes again that Applicant fails to provide an express support for newly amended elements in claim 1. In particular, since their structural limitations are absent from the Specification, it is believed that any sealed cover material would inherently read on all of the aforementioned newly added elements, as set forth above. As such, the argument that Onderak does not disclose every element of newly amended claim 1 (Remarks, page 4, paragraph 3) is not persuasive.

6. Claims ~~2~~ 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onderak et al. (US 4403009) in view of cited Juneau (US 5100716), substantially for the reasons set forth in section 5 of Paper No. 13, together with the following additional observations.

With respect to Applicant's Response arguing that Onderak or Juneau do not disclose every element of newly amended claim 1 (Remarks, page 4, paragraph 5), the Examiner repeats that it is believed that any sealed cover material would inherently read

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on all of the aforementioned newly added elements as set forth above, Applicants' argument to the contrary notwithstanding.

With respect to Applicant's argument that claim 2 recites a  $\frac{1}{4}$  inch thickness which is greater than Onderak's thickness (Remarks, page 5, first full paragraph), the Examiner repeats (see Paper No. 13, page 3, first full paragraph) that Onderak teaches that the foam layer has a thickness within the range of between about 0.05 and 0.2 inches (column 2, lines 19-20). Further, it should be noted that in claim 2, line 2, the core is recited as "approximately  $\frac{1}{4}$  inch in thickness". As such, Onderak clearly teaches the thickness as claimed.

With respect to Applicant's argument that Onderak requires additional elements such as "raised surfaces", "dams", and "surface ... structure" (Remarks, page 5, second full paragraph), it must be noted that Onderak discloses the invention as claimed. The fact that it discloses additional structure not claimed is irrelevant.

For new claims 6 and 7, although Onderak and Juneau do not expressly teach a floor covering with rounded edge, it is believed that forming a rounded edge for a floor covering with a foam core is old and conventional, motivated by the desire to improve the aesthetic appearance and/or the wear resistance of the front edge, as evidenced in Figs. 4 and 6 of cited reference Brunetto (US 5914169).

For new claim 8, the Examiner repeats (see Paper No. 13, page 4, first full paragraph) that it is believed that a suitable width, e.g., sufficient for two persons walking side by side, for a stair covering is old and conventional.

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For new claim 9, Juneau expressly teaches in Fig. 2 that the outdoor floor covering is glued or otherwise attached to a stairwell (column 2, lines 3-5).

For new claim 10, the Examiner repeats (see section 4 of Paper No. 13) that Onderak's invention is directed to an improved skid resistant flooring covering.

For new claim 11, Onderak teaches that the wear layer is formed of a polyvinyl chloride (column 2, lines 10-11) which reads on the same cover material of the instantly claimed invention, i.e., PVC (Specification, page 3). As such, it is believed that Onderak's floor covering is also inherently non-adhering to ice.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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§ 10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1300-  
1700

*Daniel Zinker*